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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/933,461 | 08/20/2001 | Richard Alan Haight | YO919980510US2 | 7338 |

7590 02/24/2009

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| EXAMINER | |
|---|---|
| EVANS, GEOFFREY S | |
| **ART UNIT** | **PAPER NUMBER** |
| 3742 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/24/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/933,461 | HAIGHT ET AL. | |
| | Examiner | Art Unit | |
| | Geoffrey S. Evans | 3742 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *7 November 2008 and 25 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *101-201* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *See Continuation Sheet* is/are allowed.

6)☒ Claim(s) *101-123,132,133,134,136-144,145/137,154,158,159,164,166,168,169,174,176,178,179,181,184,185,186,189,191,192,193,198,199/101,199/107 199/154, ,200,201/101,201/107, 201/154* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims allowed are 124-131,135,145/135,146-153,155,157,160-163,165,167,170-173,175,177,180,182,183,187,188,190,194-197,199/124,199/146,199/148,199/150,199/151,210/124,201/146,201/148,201/150,201/151.

## DETAILED ACTION

1. Claim 200 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 200 depends upon canceled claim 99. Respectfully suggest amending claim 200 to depend upon claim 199.

2. How does claim 189 further limit claim 121 ?

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 101,102,103,104,105, 108-117,118,119,120,121,122, 123,132/101, 132/102, 132/105,201/101 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5,8-23, 32/1,32/2,32/5 of U.S. Patent No. 6,333,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because generating multiple pulses (which is within the scope of "at least one laser pulse" as recited in claim 101) will create a "beam" as

recited in claim 1 of U.S. Patent No. 6,333,485. The language in claims 102-105,108-120,122,123 are respectively identical to the language in claims 2-5, 8-20, 22 and 23 of U.S. Patent No. 6,333,485 except for their dependency language. Regarding claim 121, claim 20 of U.S. Patent No. 6,333,485 recites that the laser beam has lateral gaussian profile.

5. Claims 107, 199/107 and 201/107 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,333,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 7 would result in being close to the ablation threshold substantially at the surface.

6. Claims 133,134,156,166 and 176 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 33 and 34 of U.S. Patent No. 6,333,485. Claim 33 of U.S. Patent No. 6,333,485 is identical to instant claim 133 except it recites a lateral gaussian profile that meets the limitation of a lateral profile as recited in instant claim 133. Claim 134 has identical claim language to claim 34 except for their dependency language.

7. Claims 136,158,168,178 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 36 of U.S. Patent No. 6,333,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because having the focus of the laser beam not at or beneath the surface of the material includes having the laser beam focused above the surface of the workpiece as recited in claim 36 of U.S. Patent No. 6,333,485.

8. Claims 137,138-144,145/137,154,159,164,169,174,179,184,185,186, 199/154, 201/54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37,38-44,45/37 of U.S. Patent No. 6,333,485 in view of Mourou et al. in U.S. Patent No. 5,656,186. Claim 37 meets all of the limitations of claim 137 including focusing the beam so that it is not at or beneath the surface of the material but not that the characteristic pulse width is defined by the ablation (LIB) threshold function is no longer proportional to the square root of pulse width. Mourou teaches that the characteristic pulse width can be defined by the ablation (LIB) threshold function that is no longer proportional to the square root of the pulse width. It would have been obvious to adapt claim 37 in view of Mourou et al. to provide this to prevent undesired heat effects on the workpiece during laser ablation. Claims 138-144 correspond to dependent claims 38-44 of U.S. Patent No. 6,333,485.

9. Claim 199/101 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,333,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because a plurality of laser pulses can be a beam. Claim 21 includes all of the limitations of claim 1 of U.S. Patent No. 6,333,485.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Upon filing of a proper terminal disclaimer and correction of minor informalities above this application will be in condition for allowance.

12. Claims 124-131,135,145/135,146-153,155,157, 160-163,165,167, 170, 171, 172, 173,175, 177,180,182,183,187,188,190, 194,195,196,197, 199/124,199/146, 199/148, 199/150,199/151, 201/124,201/146,201/148,201/150, and 201/151 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S. Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 7:30AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey S Evans/

Primary Examiner, Art Unit 3742